



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/502,344 Confirmation No. : 9192
First Named Inventor : Richard ROSS
Filed : May 11, 2005
TC/A.U. : 1647
Examiner : Cherie M. Chappell

Docket No. : 100042.55084US
Customer No. : 23911

Title : Polypeptide Variants

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action states that the Claims of the present application belong to two (2) separate (independent and distinct) inventions, and requires restriction. Applicants respectfully traverse. For examination purposes, applicants provisionally elect, with traverse, Group I which include Claims 1-38, 43, and 45.

Further, for examination purposes, applicants elect the SEQ ID NO: 18 (growth hormone), and "growth hormone deficiency" as the species to be initially examined.

Applicants traverse the restriction requirement for the following reasons. According to Rule 13.2, unity of invention exists when "there is a technical relationship among the claimed inventions involving one or more special technical features. The term 'special technical features' is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art." In the instant application, it is

apparent that the inventions in all pending claims involve a special technical feature, i.e., a construct comprising more than two ligand binding domains of a cytokine receptor. As a consequence, all pending claims satisfy the unity of invention requirement under PCT Rule 13.2. Specifically, applicants respectfully submit that Claim 43 depends from Claim 1, and Claim 45 depends from Claim 43. Accordingly, the restriction requirement is improper and should be withdrawn

It is not clear to applicants the exact basis of the restriction requirement. To the extent that it might be based on the U.S. practice to restrict a product and a method of using the product, applicants respectfully submit that the rules are different under the PCT unity of invention standard. The MPEP illustrates, in detail, three situations where unity of invention should be analyzed. See MPEP § 1850(B). One of the three situations is "Combinations of Different Categories of Claims:"

The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product;

...

Thus, a process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

Also an apparatus or means shall be considered to be specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus or means

corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

MPEP § 1850(C) (quoting PCT Administrative Rule 13) (underline added).

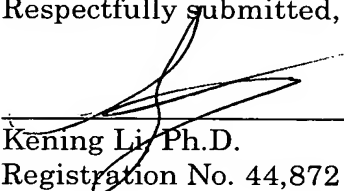
Accordingly, applicants respectfully submit that the restriction requirement is improper and should be withdrawn.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #100042.55084US).

November 30, 2005

Respectfully submitted,



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